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In re Application of:
RAMACHANDRAN, Sridhar, et al. : COMMUNICATION
U.S. Application No.: 10/596,904 :
PCT No.: PCT/US2005/018870 :
International Filing Date: 27 May 2005 :
Priority Date: 31 December 2004 :
Atty Dkt No.: NEXE-012/05US 306342-2021 :
For: METHODS AND APPARATUS FOR :
MULTISTAGE ROUTING OF :
PACKETS USING CALL :
TEMPLATES :
:

This application is before the Office of PCT Legal Administration for issues arising under 35 U.S.C. 371(c).

BACKGROUND

On 27 May 2005, applicants filed international application PCT/US2005/018870. The international application claimed a priority date of 31 December 2004, and it designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 30 June 2007. The international application named seven applicant/inventors: Sridhar RAMACHANDRAN, Paritosh TYAGI, Saravanan MALLESAN, Gaurav KULSHRESHTHA, Sohan SHETTY, Rohini RAMAN, and Medhavi BHATIA.

On 28 June 2006, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, the basic national fee.

On 23 March 2007, applicants filed a declaration that names and is executed by four persons. Three of these persons are inventors of record herein: Medhavi BHATIA, Sridhar RAMACHANDRAN, and Paritosh TYAGI; the additional person named on the declaration is David Elliot STURTEVANT.

On 11 June 2007, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Acceptance" (Form PCT/DO/EO/903) and filing receipt indicating that applicants had satisfied the requirements of 35 U.S.C. 371(c) as of 23 March 2007.

On 21 August 2007, applicants filed a “Request For Corrected Filing Receipt” which requested a change in the domestic priority listed on the filing receipt. Specifically, applicants requested that the domestic priority be corrected to include a reference to the U.S non-provisional application to which priority was claimed in the international application.¹

DISCUSSION

Section 1893.01(e) of the MPEP states the following regarding changes in the inventorship of an international application entering the national stage (emphasis added):

The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any changes effected under PCT Rule 92bis. See 37 CFR 1.41(a)(4). Accordingly, **an oath or declaration that names an inventive entity different than that set forth in the international application will not be accepted for purposes of entering the U.S. national phase unless the requirements under 37 CFR 1.497(d) are satisfied**. These requirements include: (A) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (B) the processing fee set forth in 37 CFR 1.17(i); and (C) the written consent of the assignee if an assignment has been executed by any of the original named inventors (see 37 CFR 3.73(b)).

As noted above, applicants here filed a declaration that names an inventive entity different than that set forth in the international application. Specifically, the declaration includes only three of the seven inventors of record, and it includes an additional inventor who is not of record herein.

Applicants have not submitted the materials required under 37 CFR 1.497(d), as necessary to correct the inventorship of record herein to correspond to the inventorship listed on the declaration. Accordingly, the declaration filed herein fails to comply with 37 CFR 1.497(a) in that it does not properly identify the inventors of record herein and is not executed by the inventors of record herein. Applicants have therefore not satisfied the declaration requirement of 35 U.S.C. 371(c)(4).

Based on the above, the Notification of Missing Requirements (Form PCT/DO/EO/903) and filing receipt mailed 11 June 2007, both of which incorrectly indicated that applicants satisfied the requirements of 35 U.S.C. 371(c) as of 23 March 2007, are appropriately vacated.

Applicants should also note that the present national stage application does not include a proper reference to U.S. application 11/026,746, as required under 37 CFR 1.78 for an acceptable benefit claim. Accordingly, the requested correction in domestic priority contained in applicant’s “Request For Corrected Filing Receipt” would not be appropriate on the present record. It is noted that the specification filed by applicants on 28 June 2006 included a first

¹ Specifically, applicants requested that the domestic priority read as follows: “a 371 of PCT/US05/18870 5/27/2005, which claims priority to U.S. Patent Application No. 11/026,746, filed 12/31/04).

paragraph identifying the application as "a U.S. national phase filing of International Application No. PCT/US2005/018870, filed May 27, 2005, which claims priority to U.S. Patent Application No. 11/026,746, filed December 31, 2004." However, the specification of record in a national stage application is the specification in the international application, and the new specification included with the national stage materials was not submitted as a proper substitute specification in accordance with 37 CFR 1.125. Thus, the paragraph containing the reference to the prior filed U.S. non-provisional application is not part of the specification of record herein.

Moreover, even if the present application had been properly amended to include the paragraph containing the reference to the prior U.S. non-provisional application, such reference is not in the form required by 37 CFR 1.78(a)(2)(i). Specifically, the reference does not properly indicate the relationship of the prior filed applications. See MPEP section 201.11(III)(A):

The relationship between the applications is whether the instant application is a continuation, divisional, or continuation-in-part of the prior nonprovisional application. An example of a proper benefit claim is "this application is a continuation of prior Application No. ---, filed ---." A benefit claim that merely states that "this application claims the benefit of Application No. ---, filed ---" does not comply with 35 U.S.C. 120 and 37 CFR 1.78(a)(2)(i), since the relationship between the applications is not stated.

Thus, before any subsequently issued filing receipt herein will include a reference to U.S. application 11/026,746, applicants must add a proper reference to such application in compliance with the requirements of 37 CFR 1.78. Applicants should note that, because a proper reference to the prior U.S. non-provisional application was not entered within the time period set forth in 37 CFR 1.78(a)(2)(ii), the entry of any such reference will require a grantable petition under 37 CFR 1.78(a)(3).

CONCLUSION

The declaration filed herein on 23 March 2007 fails to properly identify the inventors of record and is not executed by the inventors of record. The declaration therefore fails to comply with 37 CFR 1.497(a).

The Notification of Missing Requirements (Form PCT/DO/EO/903) and filing receipt mailed 11 June 2007, both of which incorrectly indicated that applicants satisfied the requirements of 35 U.S.C. 371(c) as of 23 March 2007, are hereby **VACATED**.

Applicants have **TWO (2) MONTHS** from the mail date of this Communication to submit a proper response. Such response must include either: (1) a revised oath or declaration acceptable under 37 CFR 1.497 that names and is executed by the correct applicants of record herein (accompanied by an explanation regarding the previous filing of the declaration naming a different inventive entity); or (2) a grantable request under 37 CFR 1.497(d) to correct the inventorship herein to correspond to that set forth in the previously filed declaration, thereby permitting acceptance of the previously filed declaration under 37 CFR 1.497.

Failure to file a timely and proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

Applicants' "Request For A Corrected Filing Receipt" is **DISMISSED** without prejudice.

As discussed above, the present application does not at present include a valid claim of benefit under 35 U.S.C. 120 and 37 CFR 1.78 to U.S. application 11/026,746, the priority application listed on the international application. The addition of such a reference at this time would require the filing of a grantable petition under 37 CFR 1.78(a)(3).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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